

**REMARKS**

**I. Introduction**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-12 are requested to be canceled. The cancellation of claims does not constitute acquiescence in the propriety of any rejection set forth by the Examiner. Applicant reserves the right to pursue the subject matter of the canceled claims in subsequent divisional applications.

Claim 14 is currently amended.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

Upon entry of this Amendment, claims 13-24 will remain pending in the application.

Because the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested.

**II. Response to Issues Raised by Examiner in Outstanding Office Action**

**a. Claim Rejections - 35 U.S.C. § 112, First Paragraph**

Claims 13 and 15-24 are rejected by the Examiner under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way to enable one skilled in the art to make and/or use the invention.. Applicant respectfully requests reconsideration and withdrawal of the rejection.

The Examiner is of the view that the specification does not fully disclose that the anti-HM1.24 antibody binds to an activated T cell, because Goto, on page 1926, second column, describes that cells bound by HM1.24 were "clearly CD3-," and therefore cells to which anti-HM1.24 has been bound are not T cells, and because Goto describes that an anti-HM1.24 antibody is an antibody specifically binding to B cells. Office Action, p. 4. However, in

Example 3 of the present application, an experimental result (Fig. 2) shows that the anti-HM1.24 antibody bound to PHA-stimulated T cells, and that the amount of HM1.24 antigen on T cells which have been activated by FHA was not decreased (Fig. 3). These experimental results show that anti-HM1.24 antibody binds to activated T cells.

Applicants have amended claim 13 to describe a method of inhibiting activated lymphocytes. As provided above, the Examples in the application describe the binding of the anti-HM1.24 antibody to activated T cells. Consequently, the current application clarifies specific cell types to which the anti-HM1.24 antibody binds. A person of skill in the art at the time of filing could perform the experiments in the application and verify these binding properties.

Although other reports exist regarding the binding of anti-HM1.24 antibody to T cells in the prior art, this application describes and enables anti-HM1.24 antibody binding to activated T cells. Therefore, Applicants request reconsideration and withdrawal of the rejection.

**b. Claim Rejections - 35 U.S.C. § 103**

Claims 13 and 15-24 are rejected by the Examiner under 35 U.S.C. § 103 as being obvious over Chang (US 5,298,420) in view of Goto *et al.* Applicant respectfully requests reconsideration and withdrawal of the rejection.

To establish a *prima facie* case of obviousness, there needs to be (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) the prior art references, when combined, must teach or suggest all the limitations of the claimed invention. *See* MPEP §2143 (Aug. 2001). “Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Applicants respectfully assert that the examiner has not met his burden.

Chang describes a method for inhibiting activity of B lymphocytes for treatment of autoimmune diseases and Goto describes treatment of multiple myeloma by HM1.24 antigen which binds to B cells at the end of the differentiation process. However, these references do

not describe a method of inhibiting the activity of activated lymphocyte. Consequently, the prior art does not teach each and every element of the claimed invention. In addition, the teachings of Chang are limited to the targeting of migis epitopes and explicitly provide that migis epitopes are not found on all activated lymphocytes . See Chang, col. 8, lines 22-25.

Chang demonstrates that immunosuppression can be established by the use of antibodies which bind epitopes that are specific extracellular regions in 5 membrane-binding types of Ig molecules. See Chang at col. 3, lines 10-30. In other words, Chang describes that migis- $\gamma$  and - $\mu$  antigens are useful because all B cells pass through a stage where they produce IgM and IgD, and that migis- $\gamma$  is useful because a large amount of IgG is present in an organism and any antibody whose epitope is migis- $\gamma$  is useful to any IgG subclass since the sequence of migis- $\gamma$  in 4 subclasses of IgG are the same. The teachings in Chang, however, do not extend beyond targeting migis epitopes and not all B cell epitopes are migis epitopes. Since the presently claimed invention does not recite the use of the membrane-binding type of Ig molecule-binding antibody, there is no motivation to combine the cited references with a reasonable expectation of successfully employing the antibody recited in the claims in a method for inhibiting the activity of activated lymphocyte.

Therefore, Applicants request reconsideration and withdrawal of the rejection.

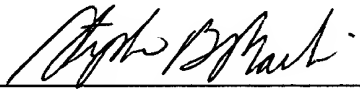
**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date June 27, 2007  
FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5571  
Facsimile: (202) 672-5399

By   
Harold C. Wegner  
Attorney for Applicant  
Registration No. 25,258  
*Reg No 35,264*